SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
MAY 16 1968
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

Nos. 1384 & 1408

MODERN PLASTIC MACHINERY CORP.,
Petitioner,

vs.

FRANK W. EGAN & COMPANY and
WILLIAM H. WILLERT,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITIONS FOR WRITS OF CERTIORARI

WILLIAM K. KERR
c/o Fish, Richardson & Neave
277 Park Avenue
New York, New York 10017
Attorney for Respondents

DAVID W. PLANT
Of Counsel

May 14, 1968

TABLE OF CONTENTS

	PAGE
Introduction	1
Opinions Below	2
Jurisdiction	3
Questions Presented	3
Statutes and Rules	4
Statement of the Case	4
1. The Proceedings Below	4
2. The Background of the Invention in Suit	5
3. The Construction and Operation of the Patented Invention	7
4. The Prior Art	13
Reasons for Denying the Writs	17
1. The Judgment and Order of the Court of Appeals Are Correct	17
2. There Is No Special or Important Reason for Reviewing This Case on Certiorari	21
Conclusion	22
Appendix A	A-1

TABLE OF AUTHORITIES

Cases

PAGE

Bates v. *Coe*, 98 U. S. 31 (1878) 19n

Borg-Warner Corporation v. *Mall Tool Company*, 220 F. 2d 803 (7 Cir. 1955), cert. denied 349 U. S. 946 (1955) 21

Graham v. *John Deere Co.*, 383 U. S. 1 (1966) ..5, 17, 21

Hamilton Shoe Co. v. *Wolf Brothers*, 240 U. S. 251 (1916) 22

Hazel-Atlas Co. v. *Hartford Co.*, 322 U. S. 238 (1944) 21

Magnum Co. v. *Coty*, 262 U. S. 159 (1923) 22

United States v. *Adams*, 383 U. S. 39 (1966) 5, 13, 17, 20, 21

Statutes and Rules

28 U. S. C. § 1254(1) 3

28 U. S. C. § 1338(a) 4

35 U. S. C. § 101 4

35 U. S. C. § 102 4

35 U. S. C. § 103 .....3, 4, 5, 17, 19n, 21

35 U. S. C. § 112 .....4, 19n

35 U. S. C. § 281 4

35 U. S. C. § 282 4

Rule 52(a) F. R. C. P. 4

Rule 60(b) F. R. C. P. 4, 21

IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

MODERN PLASTIC MACHINERY CORP.,
Petitioner,

vs.

FRANK W. EGAN & COMPANY and
WILLIAM H. WILLERT,
Respondents.

Nos. 1384 & 1408

RESPONDENTS' BRIEF IN OPPOSITION TO PETITIONS FOR WRITS OF CERTIORARI

Introduction

This ordinary patent suit has spawned two separate petitions for writs of certiorari. As we shall demonstrate in this brief, there is nothing about this case, and nothing raised in either petition, which warrants review by this Court.

The petition in No. 1384 is directed to the judgment of the United States Court of Appeals for the Third Circuit, which held valid respondents' plastic injection molding machine patent and remanded the action to the District Court to decide the issue of infringement. The petition in No. 1408 is directed to a subsequent order of the same Court of Appeals denying petitioner's "Motion for Vacating or Modifying The Judgment . . . Or Ordering a Rehearing in the District Court on the Validity of Claims 1 and 4 of the Patent In Suit."

The opinion of the Court of Appeals on the merits is consonant with this Court's recent opinions in patent cases and is manifestly right. The denial of petitioner's unorthodox motion is also proper and correct.

Neither petition is based on a conflict between the decisions of the Court of Appeals for the Third Circuit and the decision of another Court of Appeals on the same matter. Neither petition raises any unsettled question of Federal law. Except for petitioner's own conduct, there has been no departure from the accepted and usual course of judicial proceedings. No question of imperative public importance is involved.

In short, there is no special or important reason why either of the writs prayed for should be granted.

Opinions Below

The Opinion of the United States Court of Appeals for the Third Circuit (1384, App. B)* is reported at 387 F. 2d 319. The Opinion of the United States District Court for the District of New Jersey (1384, App. A) is reported at 260 F. Supp. 22.** The District Court filed no separate Findings of Fact. It ended its memorandum opinion with the statement (1384, App. A, p. 52):

> "The foregoing constitutes the Court's findings of fact and conclusions of law, in compliance with F. R. Civ. P. 52(a)."

---

*Appendix B to the petition in No. 1384. Line 9 of the second full paragraph of the Court of Appeals' opinion, appearing at App. B, p. 60, should read—Patent Office, except the German application. In addition,—.

**The Opinion of the District Court appears also in Appendix for Appellants before the Court of Appeals at 6a-39a.

Jurisdiction

The judgment sought to be reviewed in No. 1384 is dated, and was entered on, December 29, 1967. The order sought to be reviewed in No. 1408 is dated, and was filed on, April 26, 1968.

After the Court of Appeals' opinion on the merits, and before petitioner filed its motion to vacate, etc., a petition for rehearing was denied by the Court of Appeals on February 1, 1968.

The petitions seek to invoke jurisdiction of this Court under 28 U. S. C. § 1254(1).

Questions Presented

Each petition presents the same fundamental question for review (1384, Pet. p. 2; 1408, Pet. p. 2).* As framed by petitioner, however, that question improperly encompasses every legal facet of the vast subject of patent validity. At the same time, each petition is silent on a threshold procedural question.

The procedural question raised by the filing of each petition is whether or not review by this Court of the non-final judgment remanding this cause to the District Court to determine the issue of infringement, or review of the order denying petitioner's motion, is premature.

If the petition in No. 1384 seeking review of the judgment is not premature, the only substantive question properly presented by it is whether or not petitioner is entitled to another hearing on the issue of "obviousness" under 35 U. S. C. § 103. The Court of Appeals correctly held the subject matter of respondents' patent to have been unobvious to a person having ordinary skill in the pertinent art.

---

*No. 1384, Petition, page 2, and No. 1408, Petition, page 2.

A separate question raised by the second-filed petition is whether or not this Court should consider, or should order either court below to consider, evidence not made a part of the record in the trial court, and with respect to which no attempt was made to reopen or to satisfy the basic requirements that the evidence was newly discovered.

Statutes and Rules

35 U. S. C. §§ 101, 102 and 282, cited in the petitions at page 3, have no application here. They are not alluded to elsewhere in the petitions.

Rule 52(a), F. R. C. P., is not involved. The Court of Appeals did not hold any finding of fact by the District Court to have been "clearly erroneous."

On the substantive question raised in No. 1384, 35 U. S. C. § 103* is the statutory provision principally involved. 35 U. S. C. § 112* is also pertinent.

On the question raised in No. 1408, Rule 60(b), F. R. C. P.,** is involved.

Statement of the Case

1. The Proceedings Below

This is an action for infringement of respondents' Willert Patent No. 2,734,226, issued February 14, 1956, for "Injection Molding Apparatus". Jurisdiction of the court of first instance is based upon 35 U. S. C. § 281 and 28 U. S. C. § 1338(a).

---

*Reprinted in pertinent part in No. 1384, Appendix F.

**Reprinted in Appendix A to this brief.

The action was tried in the United States District Court for the District of New Jersey in March 1966. The trial occupied eight court days. The District Court held claims 1 and 4 of the Willert patent invalid because of obviousness under 35 U. S. C. § 103. Infringement was litigated, but not adjudicated.

The United States Court of Appeals for the Third Circuit concluded, in a careful opinion, that the District Court had not correctly applied the legal test of obviousness in light of this Court's recent instructions in *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), and *United States* v. *Adams*, 383 U. S. 39 (1966). The Court of Appeals, relying on these recent authorities as "a guiding beacon" (1384, App. B, p. 54), held the Willert patent valid under § 103.*

2. The Background of the Invention in Suit

The Willert patent (581a, 62a),** as the Court of Appeals accurately stated (1384, App. B, p. 54),

> "relates to a plastics injection molding machine for plasticizing and delivering to a mold plastics materials at high speed and under high pressure, and under critically controlled conditions."

The outstanding characteristic of the Willert device is its ability, with speed, efficiency and simplicity, to achieve optimum mixing and plasticizing of a precise amount of any of a number of plastics materials having widely ranging

---

*These are the only proceedings in which the merits of the Willert patent have been adjudicated. The action in the United States District Court for the District of Connecticut, referred to at pages 2 and 6 of the petition in No. 1384, was commenced on February 23, 1968, and settled by defendant taking a license under the Willert patent. The action was dismissed on May 8, 1968. No other action relating to this patent is pending.

**Appendix for Appellants before the Court of Appeals, pages 581a and 62a.

properties. The Court of Appeals pointed out (1384, App. B, p. 59) that this vital characteristic is attributable to the "back pressure" feature and the "shot size control" feature —"the essence of Willert's claimed invention." On this point, the District Court correctly found (1384, App. A, p. 41):

> ". . . from the time of his first amendment of his application, Willert consistently, and with ultimate success in the Patent Office, maintained that the embodiment in a reciprocating, rotatable screw plasticizer of 'means for controlling back pressure and controlling the shot size', producing 'a properly homogenized and melted [predeterminable] amount of plastic' amounted to invention over the prior art." (Court's insertion)

Respondent Willert conceived his invention in 1950 and filed his application for patent in 1952. Since the 1930's many skilled workers in the plastics injection molding machine field had devoted much time and energy in a futile search for an adequate plasticizing and injection unit. The acute problem facing the industry are detailed both by the Court of Appeals (1384, App. B, pp. 55-56) and by the District Court (1384, App. A, pp. 21-22). Where many others in this country and abroad had failed, Willert had the perspicacity to find among the same components available to all in the field a new combination of old elements. By interrelating these old elements in his new combination, Willert succeeded in solving the industry's long-standing problem.

In 1958, respondent Egan Company became the exclusive licensee under the Willert patent. At the time of trial in March 1966, Egan Company had sold more than eleven million dollars worth of units under the Willert

patent (613a, 115a, 116a, 120a), and had granted licenses to practice the patented invention to seventeen domestic and foreign manufacturers (611a, 111a-112a).

Three industry witnesses (a molding machine manufacturer, a supplier of plastics resins and a molding machine user) testified to the striking advantages attributable to Willert's invention (164a-174a, 174a-183a, 189a-111a).

And, finally, as the Court of Appeals appropriately noted (1384, App. B, p. 62n), petitioner's executive vice-president had publicly acclaimed the virtues of the Willert type of device and had characterized "controlled back pressure" as "the real break-through" (637a, 187a-189a).*

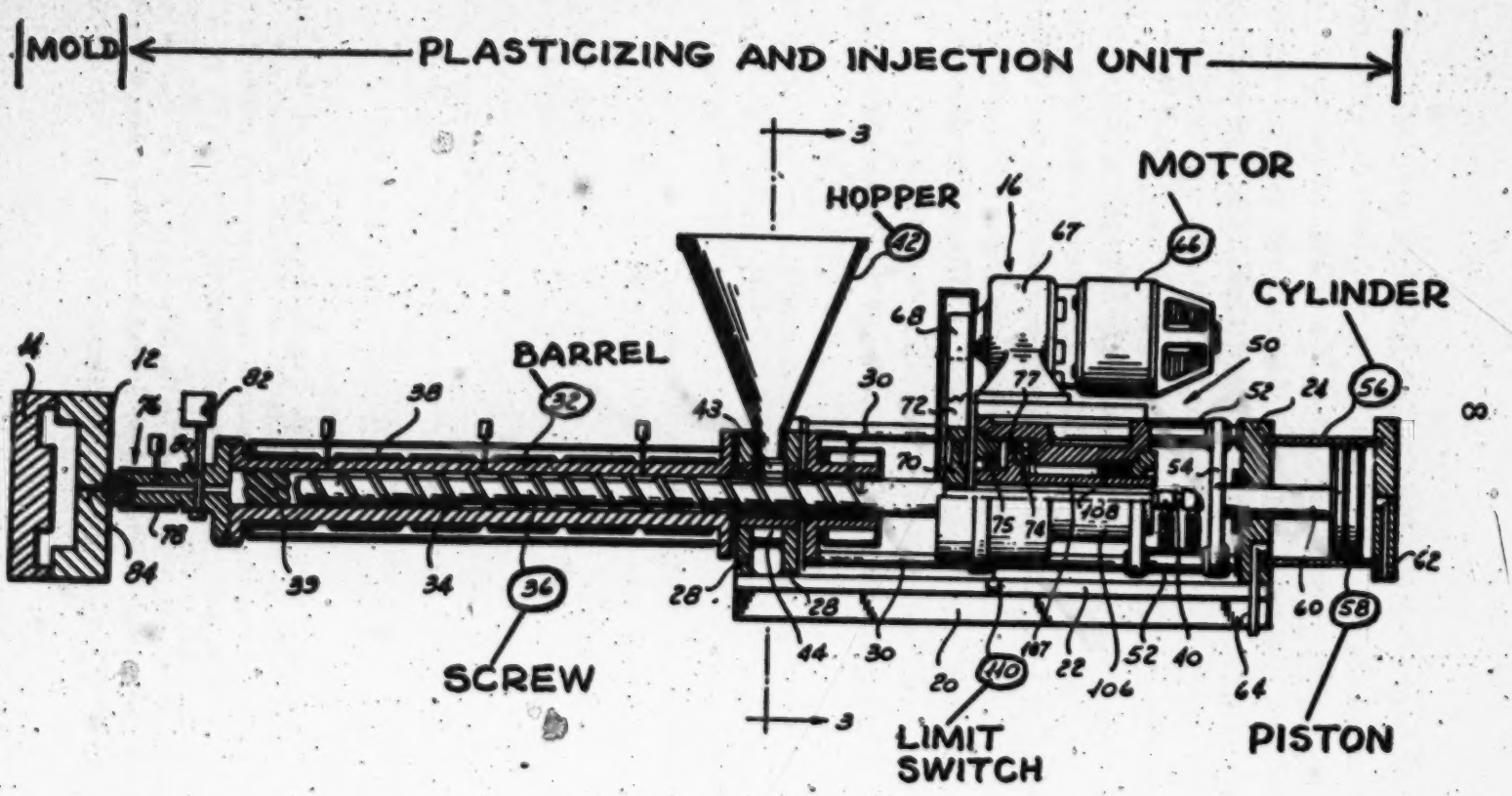
3. The Construction and Operation of the Patented Invention

An understanding of the construction and operation of the Willert unit puts into proper perspective the contentions made by petitioner. The opinion of the Court of Appeals summarizes admirably and accurately the Willert construction and operation (1384, App. B, pp. 58-59).

As illustrated in figure 2 of the Willert patent, reproduced on the next page, a plastics injection molding machine consists of two basic units: (1) the plasticizing and injection unit and (2) the mold. The placticizing and injection unit, to which the Willert invention is directed, is shown in detail; the mold, schematically.

---

*Petitioner's criticisms (1384, Pet. pp. 8-9, 16-17) of the Court of Appeals' reliance on this quotation are blended of equal parts of sophistry and semantics. The Court of Appeals properly and explicitly rejected these same contentions, declaring (1384, App. B, p. 62): "Notwithstanding the protestations of the defendant, the record adequately demonstrates that its own experts hailed the precise point of Willert's invention, the importance of the concept and its significance."


MOLD
PLASTICIZING AND INJECTION UNIT
3
HOPPER
42
16
MOTOR
46
47
CYLINDER
56
48
50
52
24
BARREL
32
30
72
77
43
14
12
82
38
70
54
75
74
108
78
84
39
34
36
28
28
62
60
58
44
30
20
110
107
22
52
40
106
64
3
SCREW
LIMIT
SWITCH
PISTON

The Willert plasticizing and injection unit consists of:

a plasticizing barrel 32,

a hopper 42 for feeding plastics resin, in the form of dry powder or pellets, into the barrel,

a screw 36 which rotates (turns) and reciprocates (Travels back and forth) within the barrel,

a motor 66 and appropriate gearing for rotating the screw,

a limit switch 110 for controlling the amount of rearward travel of the screw, and

a hydraulic cylinder 56, and piston 58 connected to screw 36, both parts of the hydraulic system which controls the magnitude of the "back pressure."

The hydraulic system, depicted fully in figure 4, reproduced on page 10, will be discussed presently.

Plastics resin is introduced through hopper 42 to the empty plasticizing barrel 32. The rotating screw 36 plasticizes (melts) and mixes the resin, and conveys it along the threads of the screw to the front of the closed barrel. As the plasticized resin accumulates in front of the rotating screw, it forces the screw to retreat (move rearwardly) in the barrel. The retreat of the screw, and its associated piston, is opposed and controlled by a selected, constant "back pressure" in the hydraulic system.

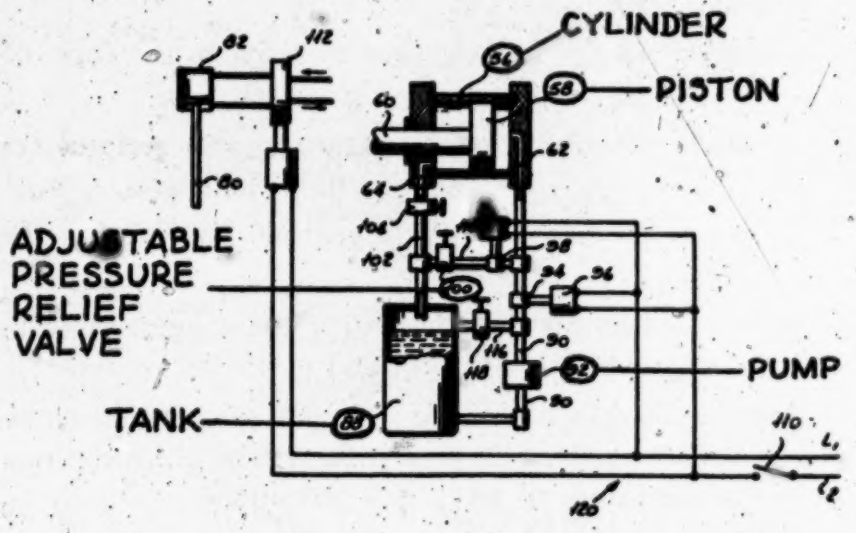
As illustrated in figure 4, *infra*, the hydraulic system is composed of:

the hydraulic cyclinder 56 and piston 58,

a pump 92,

a tank 88, and

adjustable pressure relief valve 100, and various connecting piping and valves.



As the screw is pushed rearwardly by the accumulating resin, piston 58 in figure 4 moves to the right, forcing oil out of cylinder 56, through port 62, pipe 114 and adjustable pressure relief valve 100, and into tank 88. The amount of "back pressure" constantly resisting the rearward movement of the piston and screw is selected by an appropriate setting of adjustable pressure relief valve 100.

The function of the adjustable pressure relief valve 100—to maintain at a selected magnitude the hydraulic force which opposes the travel of the piston and the screw in a rearward direction—together with the condition (i.e., open or closed) of the valves in the hydraulic system to achieve the desired hydraulic force are spelled out in the Willert patent at 586a, column 6, lines 8-16 (75a, 83a, 123a, 562a-563a):

> "The force at which the screw will retreat is controlled by the hydraulic cylinder 56, to which

the screw is connected through the medium of carriage 50. Referring to Fig. 4, at the described portion of the operating cycle valve 94 is closed, valve 98 is open, and *pressure relief valve 100 is set so that the feed screw retreats under a given thrust load.* During the retreating of the screw the oil from the cylinder 56 runs through pipes 90 and 102 back to the tank 88." (Emphasis added)

The significant advantages which accrue from the use of adjustable back pressure are set forth in the Willert patent specification at 584a, column 1, lines 55-65 (87a-88a):

> "Briefly the apparatus of the present invention when employed in conjunction with a mold such as that of an injection molding machine, produces a homogeneous mass of plastic compound free of volatile matter, air, or other condensable substances, in an optimum plasticized state to be injected into such mold or into a transfer cylinder, if the latter is used. The resulting molded article is characterized by its uniformity, freedom from strain, and the faithfulness with which it follows even the finest and most intricate details of the mold cavity."

The adjustable pressure relief valve 100 and associated hydraulic circuitry are called for by element (f) of Willert patent claims 1 and 4 in suit (587a):

> "means for selectively forcibly but yieldingly opposing reciprocation of the screw in the passage in a rearward direction."

The quantity of properly plasticized resin (i.e the "shot") permitted to accumulate in front of the screw is controlled by positioning limit switch 110 to the left or to

the right. The position of switch 110 is selected to stop rearward movement of the screw at the precise moment when the screw has retreated a distance sufficient to provide in the front of the barrel a quantity of plasticized resin equal to the volume of the mold employed. Thus, only the quantity of plastics material required for each mold cycle is plasticized and accumulated in front of the screw. This "shot size control" feature performs the important functions of increasing the degree of homogeneity of each charge and the uniformity of homogeneity from charge to charge.

The structure, and its operation, for controlling the size of the charge which accumulates in front of the screw is described in the patent at column 5, lines 1-8 (586a):

> "A limit switch, generally indicated at 110, is provided on the bed 22 of the unit 16, so as to be adjustable longitudinal of such bed, in such position as to be closed by the carriage 50 when the latter has traveled a predetermined distance to the right. As a result the volume of the plastic material receiving reservoir 39 may be adjusted so as substantially to equal the volume of the mold employed."

Element (g) of patent claims 1 and 4 describes this feature of the Willert invention.

When the rearward movement of the screw is stopped upon the tripping of limit switch 110, the accumulated charge is ready for injection into the mold. With the mold in condition, i.e., empty and closed, to receive a new charge, the Willert circuitry causes appropriate resetting of the valves in the hydraulic system so as to cause pump 92 to exert a large hydraulic force on the right hand face of piston 58. This propels the piston to the left, forcing the screw rapidly forward and injecting the accumulated plasticized resin into the mold.

With the screw in its most forward position in the barrel, the cycle of plasticization, accumulation and injection of a new charge is ready to be repeated.

The Court of Appeals' opinion (1384, App. B, pp. 55-59) reflects a thorough and accurate understanding of Willert's inventive contribution, including not only the construction and operation of the patented invention but also the advantages which flow from its utilization.

4. The Prior Art

No prior art patent or publication, including the one on which petitioner's unsuccessful motion to vacate, etc., and its petition in No. 1408 are based, shows or suggests the inventive contribution of Willert. The conceded fact that each structural element of Willert's patented combination was old does not diminish the magnitude of his contribution. On the contrary, the circumstance that other workers in the art had available to them the same structural elements as those ultimately selected and combined by Willert underscores the extent of Willert's advance. The Court of Appeals' opinion, specifically recognizing that the Willert combination was made up of old elements (1384, App. B, p. 61), unhesitatingly and properly held the patent valid. In doing so, it accorded to the Willert combination patent the same cachet of patent validity accorded to other unobvious combinations of old elements, e.g., *United States* v. *Adams*, 383 U. S. 39 (1966).

Petitioner's principal position appears to be that each prior art reference relied on in No. 1384 teaches the concept of utilizing adjustable back pressure to compact the plastic (1384, Pet. pp. 12, 13). Taking each reference briefly and chronologically, it is clear that none, nor a collection of any of them, teaches this significant aspect of the Willert invention:

1. The Italian patent (658a, 236a), applied for in 1940, suggests the use of a reciprocating screw to mold articles

of rubber. Petitioner's expert witness conceded (311a), and the Court of Appeals properly stated (1384, App. B, p. 62), that the Italian patent makes no mention of adjustable back pressure.

2. The Wiedmann patent (683a, 255a), applied for in 1942, shows a means for controlling a "back pressure" on the cutting edge of a machine tool. Petitioner here asserts, notwithstanding the absence of any supporting evidence in the record, that Wiedmann's arrangement maintains a "constant back-pressure" (1384, Pet. p. 15). This is wrong. The Wiedmann patent calls for a midstroke change in hydraulic pressure from "relatively high" to "low" (686a, col. 2, lines 33-60). Wiedmann's device serves a function foreign to that employed by Willert in his plastics injection molding machine. The Court of Appeals correctly characterized Wiedman's hydraulic system as "in a different context" and "remote cited art" (1384, App. B, p. 61).

3. With regard to Beck's German patent application (725a, 276a), filed in 1943, both petitioner's patent expert and Beck himself, petitioner's trial expert on plastics and plastic machinery, conceded (352a-353a, 388a-390a) that the Beck application makes no mention of adjustable back pressure. Indeed, there is no reference, written or pictorial, in the patent to the concept of applying or controlling any pressure to resist the rearward travel of the screw.

4. The Willcox patent (680a, 249a), applied for in 1950, has a screw which is pulled rearwardly by hydraulic force. The screw is not, and because of the design of the machine cannot be, forced to retreat by the accumulation of plasticized material in front of the screw, as both petitioner's patent expert and respondents' expert agreed (306a, 550a-552a). Petitioner's patent expert agreed also

that as Willcox's screw is pulled rearwardly, there is no adjustable back pressure (309a). With a characteristic unwillingness to recognize any testimony or evidence unfavorable to its position, petitioner blindly persists in contending here (1384, Pet. p. 11) that Willcox "shows a control valve which is used to permit the screw to retreat and opposes retreat . . ." Such a valve is nowhere to be found in the written or diagrammatic description of the Willcox device. Indeed, Willcox refers only in passing to "a valve arrangement" which he plainly says is "not shown" (682a, col. 3, lines 17-18).

5. The Beck article (741a, 434a), published in 1950, refers briefly to a reciprocating screw machine (757a) and is conspicuously silent with regard to any pressure opposing rearward travel of the screw, to say nothing of an adjustable back pressure.

The Beck article is noteworthy only for its recitation of the serious problems facing the injection molding machine designer seven years after the filing of Beck's German patent application which, petitioner asserts, teaches Willert's solution.

In 1950, Beck wrote (751a):

> "The basic problem of the injection molding machine is the *injection cylinder* in which the injection molding compound must be placed in a necessary and sufficiently plastic state. Here it is necessary to master a problem of heat engineering, which affords no little difficulty." (Emphasis in original)

Finally, the 1925 patent to Kaiser (1408, App. B), the subject of No. 1408, is not newly discovered, shows no more than the art considered by the Patent Office and by the courts below and is dissimilar from the patent in suit. The Kaiser patent was cited in the Patent Office as a reference

against the application for the 1949 Cousino patent 2,471,-813 (689a, at 694a, 260a). The Cousino patent, in turn, was cited by the Patent Office against Willert's patent application (588a) and relied upon by petitioner in both courts below. Both Cousino and Kaiser show an extruder with a feed screw which acts as a valve by oscillating slightly against a hydraulic force or a spring force or both. The screw does not and cannot retreat in the barrel during plasticization to accumulate a charge and does not and cannot move forward to inject the charge into a mold. Kaiser was readily available to petitioner below, it adds nothing to the prior art considered by each tribunal below, and it differs distinctively from the Willert invention.

The facts plainly demonstrate, as the Court of Appeals correctly held (1384, App. B, pp. 61-62):

> "Here, in our view, Willert employs a method of achieving the result needed by the industry conceptually different from that disclosed by the prior art, and indeed, uses the hydraulic 'back pressure' in a manner neither indicated by the prior art nor obvious to a person skilled in the art, at least on the record of this case.
>
> * * *
>
> "It remained for Willert to recognize that adjustable back pressure, of sufficient magnitude, created through the use of hydraulic force opposing the retreat of the screw, resulted in eliminating substantial problems of the industry. It is the back pressure which causes more internal heat to be generated, obtaining greater uniformity of heat and its distribution, so essential to the proper plasticization and homogenization of the plastics material; speeds up the process, and reduces the likelihood of air bubbles and similar disruptive occurrences.
>
> * * *

"In summary, we conclude that the Willert invention is novel, has utility and not obvious to one having ordinary skill in the art to which its subject matter pertains, and that it represents a significant advance in the field."

Reasons for Denying the Writs

1. The Judgment and Order of the Court of Appeals Are Correct

At the outset of its opinion, the Court of Appeals carefully framed the question before it (1384, App. B, p. 53):

> "Did the District Court correctly apply the controlling legal test of 'obviousness' of Section 103 of the Patent Act of 1952, 35 U. S. C. A, . . .?"

To resolve that question, the Court of Appeals turned (1384, App. B, pp. 54-55, 60-62) to the provisions of 35 U. S. C. § 103 and to the recent opinions of this Court in *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), and *United States* v. *Adams*, 383 U. S. 39 (1966).

After "applying the teachings of the *Graham* and *Adams* cases" (1384, App. B, p. 55), the Court of Appeals correctly decided that the District Court had misapplied those teachings (e.g., App. B, p. 61) and that "the claimed invention was not 'obvious' within the statutory meaning . . ." (1384, App. B, p. 55). The Court of Appeals gave "measured weight" to the so-called secondary considerations and concluded that the Willert invention "represents a significant advance in the field" (1384, App. B, p. 62).

Petitioner seeks to undercut the soundness of these holdings by contending that respondents misled the Court

of Appeals in asserting there a "new theory" (1384, Pet. pp. 7-8) that the "alleged novel concept" was "adjustable back pressure" (1384, Pet. p. 6, also p. 7), said by petitioner to be an "afterthought" (1384, Pet. p. 11) and a "fiction" (1384, Pet. p. 12). The captious character of this contention is exposed by the following:

The District Court found as a fact that (1384, App. A, p. 41; *supra*, p.6):

> ". . . from the time of his first amendment of his application, Willert consistently . . . maintained that the embodiment in a reciprocating, rotatable screw plasticizer of *'means for controlling back pressure* and controlling the shot size', producing 'a properly homogenized and melted [predeterminable] amount of plastic' amounted to invention over the prior art" (Court's insertion; our emphasis)

In addition, the District Court epitomized respondents' contentions in that court as follows (1384, App. A, p. 38):

> "In short, plaintiffs [respondents] state that 'the crux of the Willert invention is this adjustable back pressure which resists the rearward movement of the screw.'"

In the Court of Appeals, respondents continued to urge, as they had consistently urged in the Patent Office and in the District Court, and as they urge in this Court:

> "The important part of Willert's invention was his recognition of the extraordinary advantages which would flow from adjustable back pressure and from shot size control. Nobody had recognized this before Willert." (Brief for Appellants, p. 27)

* * *

> "The invention in Willert's new combination lies in the recognition, by Willert alone, after many failures by others, that the critical, long-standing problem of controlling resin plasticization could be solved by providing an adjustable back pressure against which the plasticizing screw could retreat." (Reply Brief, p. 8)

Thus, it is manifest that since the pendency in the Patent Office of the application for the Willert patent, it has consistently been, and continues to be, respondents' position that Willert's inventive contribution lay in his perception of the unexpectedly beneficial role that adjustable back pressure, in concert with other elements, could play in an injection molding machine. This inventive contribution of adjustable back pressure to the injection molding art is a vital fact, not a "fiction". Petitioner's own *ex-litem* public utterances make this plain (637a; *supra*, p. 7):

> "The actual charging of the front chamber under controlled back pressure is the real break-through in this new plasticizing concept."

And the Willert patent specification and claims illustrate, describe in words, and claim this adjustable back pressure feature, *supra*, pages 7-13.*

---

*With respect to claims 1 and 4, petitioner asserts (1384, Pet. p. 11) that the claims must be construed as calling for "any means" for applying the appropriate back pressure, and, thus, are "anticipated" by the prior art. This assertion is in plain disregard of the language of 35 U. S. C. § 112, upon which petitioner relies, and which specifies that a "means" claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." It also distorts the doctrine of "anticipation", which applies only when the entire claimed invention is "identically disclosed or described" in a single prior art reference, 35 U. S. C. § 103, *Bates* v. *Coe*, 98 U. S. 31, 48 (1878).

What petitioner fails to come to grips with, and seeks to divert this Court's attention from, is that the District Court as a matter of law applied an improper test of patentability to the Willert invention. The District Court held that, because a structural element, which could have been (but had never been) used to select and maintain a back pressure in a plastics injection molding machine, was in the prior art, the combination invented by Willert was obvious *per se* (1384, App. A, pp. 49-50).

But as this Court stated in *United States* v. *Adams*, 383 U. S. 39, 50 (1966):

> "It begs the question . . . to state merely that magnesium and cuprous chloride were individually known battery components. If such a combination is novel, *the issue is whether bringing them together as taught by Adams was obvious in light of the prior art.*" (Emphasis ours)

It is this definition of the issue which the Court of Appeals properly adopted and correctly applied to the controlling facts (1384, App. B, pp. 61-62). In holding that Willert's invention was not obvious, the Court of Appeals expressly rejected the District Court's erroneous *"per se"* test of patentability (1384, App. B, p. 61):

> ". . . the mere fact that the elements are concededly old does not itself militate against patentability, as the District Court seems to suggest,"

and accurately observed (1384, App. B, p. 62):

> "It remained for Willert to recognize that adjustable back pressure, of sufficient magnitude, created through the use of hydraulic force opposing the retreat of the screw, resulted in eliminating substantial problems of the industry."

As for No. 1408, no timely or adequate showing has been made to support any grant of relief to petitioner under the provisions of Rule 60(b), F.R.C.P. *Hazel-Atlas Co.* v. *Hartford Co.*, 322 U. S. 238 (1944) (1408, Pet. pp. 4-5), is not apposite. There is no suggestion of fraudulent conduct here and none exists.

Borg-Warner Corporation v. *Mall Tool Company*, 220 F. 2d 803 (7 Cir. 1955), cert. denied 349 U. S. 946 (1955), cited by petitioner (1408, Pet. p. 5), is, however, singularly apposite. In that patent case, the Court of Appeals denied defendant's motion to reopen its decision reversing in part a trial court judgment in favor of defendant. The court held (220 F. 2d at 806) that defendant had not met "the prerequisite for the allowance of a motion such as this . . . that the prima facie evidence be of such weight as to necessitate a different result. . . ." Our discussion, *supra*, pages 15-16, demonstrates that this petitioner, both in this Court and in the Court of Appeals, has failed to satisfy that prerequisite.

2. There Is No Special or Important Reason for Reviewing This Case on Certiorari

The decision of the Court of Appeals on the merits is in accord, rather than in conflict, with the recent opinions of this Court in the *Graham* and *Adams* cases. Those opinions recited fully and clearly the considerations pertinent to the application of the provisions of 35 U. S. C. § 103 to the facts germane to the legal question of obviousness. The decision of the Court of Appeals has done nothing to unsettle any important question resolved in those cases.*

---

*Notwithstanding its earlier contentions to the contrary (1384, Pet. p. 5), petitioner ultimately acknowledges (1384, Pet. p. 13) that this Court has recently dealt in full with the patent validity question presented here.

In an endeavor to create an artificial air of unusual importance, petitioner asserts that "numerous manufacturers" here and abroad have been "threatened", raises the spectre of "numerous additional suits", and attributes virtual omnipotence to respondents in having "forced 17 licensees into an agreement" (1384, Pet. pp. 6, 17). The fact is that the majority of the industry has paid tribute to the Willert patent by accepting licenses at a reasonable royalty under the patent. Industry witnesses, only one of whom was a licensee, testified enthusiastically to the extraordinary results achieved with the Willert invention. And, significantly, no suit has been brought by a declaratory judgment plaintiff.

Moreover, the judgment and the order of which review is here sought are not final. This fact, "of itself alone", is sufficient ground for denial of these petitions, *Hamilton Shoe Co.* v. *Wolf Brothers,* 240 U. S. 251, 258 (1916).

Conclusion

These petitions represent nothing more than attempts by a defeated litigant to obtain further review on the merits of a judgment of patent validity. Petitioner has had more than his day in court on this issue. His contentions, repeated once more here, have already been three times rejected by the Court of Appeals. The Court's remarks in *Magnum Co.* v. *Coty,* 262 U. S. 159, 163 (1923) apply with equal force here:

> ". . . The jurisdiction [to bring up cases by certiorari] was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

The instant petitions are open to question from the procedural standpoint and are lacking in substantive merit. They should be denied.

Respectfully submitted,

WILLIAM K. KERR
c/o Fish, Richardson & Neave
277 Park Avenue
New York, New York 10017
Attorney for Respondents

DAVID W. PLANT
Of Counsel

May 14, 1968